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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,170	11/13/2006	Frank B. Stamps	0837RF-H532-US	5513

38441 7590 03/25/2010
LAW OFFICES OF JAMES E. WALTON, PLLC
1169 N. BURLESON BLVD.
SUITE 107-328
BURLESON, TX 76028

EXAMINER

BURCH, MELODY M

ART UNIT

PAPER NUMBER

3657

MAIL DATE

DELIVERY MODE

03/25/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,170

Applicant(s)

STAMPS ET AL.

Examiner

Melody M. Burch

Art Unit

3657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/10/10 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5, 6-9, 11, 13, 15-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5374039 to Schmidt et al.

Re: claims 1, 5, 15, and 20. Schmidt et al. show in figures 6 and 7 a damper having an adjustable spring rate comprising a damper having an adjustable spring rate comprising a piston 22, 55 having an axis, an outer surface and opposing ends, a housing 32, at least one elastomeric seal 24 in sealing contact with the outer surface of the piston, the at least one seal being coaxial with the piston and limiting movement of the piston to a path along the axis of the piston, the at least one seal also defining fluid chambers adjacent the ends of the piston, the at least one seal also being fixed to the

housing, a primary passage shown in the area of 84 and 98 in figure 7 communicating the fluid chambers and a selectively switchable valve 82 for controlling a flow of fluid from one of the chambers to another of the chambers through the primary passage; and wherein when the flow of fluid through the primary passage is permitted, movement of the piston is resisted by a first spring rate due to a shear force required to cause shear deflection of the at least one seal, and when the flow of fluid through the primary passage is restricted, movement of the piston is resisted by a second spring rate due to a fluid force required to cause bulging deflection of the at least one seal.

Schmidt et al. are silent with regards to the at least one seal being a plurality of seals. In *re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

Re: claims 3 and 13. Schmidt et al. show in figure 7 wherein the switchable valve 82 is located within the primary passage.

Re: claims 6-9, 11, and 16-18. Schmidt et al. show in figure 7 the limitation of a secondary or bypass passage 68 communicating the fluid chambers.

4. Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5374039 to Schmidt et al. in view of US Patent 5535861 to Young.

Re: claims 2 and 12. Schmidt et al. are silent with regards to the elastomeric seals being formed of layers of an elastomeric material and a rigid non elastomeric material.

Young teaches the use of elastomeric seals being formed of layers of an elastomeric material 23 and a rigid non elastomeric material 26.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the elastomeric seals of Schmidt et al., as modified, to have included layers of an elastomeric material and a rigid non elastomeric material, as taught by Young, in order to provide a means of having seals with adequate stiffness for improved product reliability.

5. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5374039 to Schmidt et al. in view of US Patent Application 2006/0162778 to Nichols et al.

Schmidt et al. include a switchable valve that is pressure operated but are silent with regards to the switchable valve being electrically operated.

Nichols et al. teach in paragraph [0021] that pressure operated valves may be switched to electrically operated solenoid valves.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the pressure operated valve of Schmidt et al. to have been electrically operated, in view of the teachings Nichols et al., in order to provide an alternate but functionally equivalent means of enabling and restricting fluid flow.

6. Claims 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5374039 to Schmidt et al. in view of US Patent 2774553 to Jensen.

Schmidt et al. are silent with regards to the bypass passage having a bypass valve located within it.

Jensen teaches in figure 5 the use of a bypass passage shown surrounding element 148 including a bypass valve 148.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the bypass passage of Schmidt et al. to have included a bypass valve, as taught by Jensen, in order to provide a means of selectively controlling the fluid flow through the bypass passage.

Response to Arguments

7. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. Examiner notes that the restriction of 3/4/09 has been withdrawn.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on 571-272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mmb
March 23, 2010

/Melody M. Burch/
Primary Examiner, Art Unit 3657